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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,054	08/30/2001	Seiichi Araki	109536-161	8743

23483 7590 06/25/2003

HALE AND DORR, LLP
60 STATE STREET
BOSTON, MA 02109

EXAMINER

WEDDINGTON, KEVIN E

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 06/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,054

Applicant(s)

Araki et al.

Examiner

Kevin E. Weddington

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 10, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8 6) ☐ Other:

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CLAIMS 1-54 ARE PRESENTED FOR EXAMINATION.

AGAIN, THE PRELIMINARY AMENDMENT FILED AUGUST 30, 2001 HAS BEEN RECEIVED AND ENTERED. HOWEVER, THE AMENDMENT DOES NOT COMPLY WITH 37 CFR. 1.173(b) AS ALL ADDED CLAIMS MUST BE ENTIRELY UNDERLINED.

APPLICANTS' AMENDMENT FILED MARCH 10, 2003 HAS BEEN RECEIVED, BUT NOT ENTERED AS IT DOES NOT COMPLY WITH 37 CFR 1.173(b)

ACCORDINGLY, THE REJECTION MADE UNDER 35 U.S.C. 103 AS SET FORTH IN THE PREVIOUS OFFICE ACTION AT PAGES 4-6 IS HEREBY WITHDRAWN.

REISSUE APPLICATIONS

THIS REISSUE APPLICATION WAS FILED WITHOUT THE REQUIRED OFFER TO SURRENDER THE ORIGINAL PATENT OR, IF THE ORIGINAL IS LOST OR INACCESSIBLE, AN AFFIDAVIT OR DECLARATION TO THAT EFFECT. THE ORIGINAL PATENT, OR AN AFFIDAVIT OR DECLARATION AS TO LOSS OR INACCESSIBILITY OF THE ORIGINAL PATENT, MUST BE RECEIVED BEFORE THIS REISSUE APPLICATION CAN BE ALLOWED. SEE 37 CFR 1.178.

APPLICANTS STATED THAT A COPY OF THE OFFICE TO SURRENDER DECLARATION IS ATTACHED, BUT THE COPY IS NOT INCLUDED WITH THE AMENDMENT.

IN ADDITION, THE STATEMENT UNDER 37 CFR 3.37(b) AND ALSO CONSENT OF ASSIGNEE ARE DEFECTIVE IN THAT NO TITLE OR AUTHORITY IS SUPPLIED FOR THE PERSON SIGNING.

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ALLOWABLE SUBJECT MATTER

CLAIMS 1-8 ARE ALLOWABLE.

DOUBLE PATENTING

A REJECTION BASED ON DOUBLE PATENTING OF THE "SAME INVENTION" TYPE FINDS ITS SUPPORT IN THE LANGUAGE OF 35 U.S.C. 101 WHICH STATES THAT "WHOEVER INVENTS OR DISCOVERS ANY NEW AND USEFUL PROCESS ... MAY OBTAIN A PATENT THEREFOR ..." (EMPHASIS ADDED). THUS, THE TERM "SAME INVENTION," IN THIS CONTEXT, MEANS AN INVENTION DRAWN TO IDENTICAL SUBJECT MATTER. SEE *MILLER V. EAGLE MFG. Co.*, 151 U.S. 186 (1894); *IN RE OCKERT*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); AND *IN RE VOGEL*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A STATUTORY TYPE (35 U.S.C. 101) DOUBLE PATENTING REJECTION CAN BE OVERCOME BY CANCELING OR AMENDING THE CONFLICTING CLAIMS SO THEY ARE NO LONGER COEXTENSIVE IN SCOPE. THE FILING OF A TERMINAL DISCLAIMER CANNOT OVERCOME A DOUBLE PATENTING REJECTION BASED UPON 35 U.S.C. 101.

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CLAIMS 11, 21, 31 AND 48-54 ARE AGAIN REJECTED UNDER 35 U.S.C. 101 AS CLAIMING THE SAME INVENTION AS THAT OF CLAIMS 1 AND 2 OF PRIOR U.S. PATENT No. 5,814,632.

APPLICANTS' REMARKS REGARDING THE 35 U.S.C. 101 AS CLAIMING THE SAME INVENTION ARE NOT PERSUASIVE SINCE THE APPLICANTS DID NOT ADDRESS THE ISSUES SET FORTH BY THE EXAMINER IN THE PREVIOUS OFFICE ACTION DATED SEPTEMBER 4, 2002.

THIS IS A DOUBLE PATENTING REJECTION.

CLAIM REJECTIONS - 35 U.S.C. § 112

THE FOLLOWING IS A QUOTATION OF THE FIRST PARAGRAPH OF 35 U.S.C. 112:

THE SPECIFICATION SHALL CONTAIN A WRITTEN DESCRIPTION OF THE INVENTION, AND OF THE MANNER AND PROCESS OF MAKING AND USING IT, IN SUCH FULL, CLEAR, CONCISE, AND EXACT TERMS AS TO ENABLE ANY PERSON SKILLED IN THE ART TO WHICH IT PERTAINS, OR WITH WHICH IT IS MOST NEARLY CONNECTED, TO MAKE AND USE THE SAME AND SHALL SET FORTH THE BEST MODE CONTEMPLATED BY THE INVENTOR OF CARRYING OUT HIS INVENTION.

CLAIMS 9-54 ARE REJECTED UNDER 35 U.S.C. 112, FIRST PARAGRAPH, AS CONTAINING SUBJECT MATTER WHICH WAS NOT DESCRIBED IN THE SPECIFICATION IN SUCH A WAY AS TO REASONABLY CONVEY TO ONE SKILLED IN THE RELEVANT ART THAT THE INVENTOR(S), AT THE TIME THE APPLICATION WAS FILED, HAD POSSESSION OF THE CLAIMED INVENTION.

APPLICANTS' SPECIFICATION DOES NOT TEACH OR DISCLOSE THE PHRASE "A COMPOSITION FORMULATION ADDITIVE", AS DISCLOSED CLAIMS 9, 19, 29, 39, 48

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AND 52. THE REMAINING CLAIMS ARE REJECTED TO THE EXTENT THAT THEY INCORPORATE THE ABOVE TERMINOLOGY.

CLAIMS 9-54 ARE NOT ALLOWED.

CONCLUSION

THIS ACTION IS MADE FINAL. APPLICANT IS REMINDED OF THE EXTENSION OF TIME POLICY AS SET FORTH IN 37 CFR 1.136(A).


A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO EXAMINER K. WEDDINGTON WHOSE TELEPHONE NUMBER IS (703) 308-1235.

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Kevin E. Weddington
Primary Examiner
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K. WEDDINGTON

JUNE 24, 2003